

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: HOFFMAN, Arnold et al Examiner: ANDERSON, James D.
Application No.: 10/621,326 Art Unit: 1614
Filed: April 17, 2004
For: REDOX THERAPY FOR TUMORS

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**PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED CLAIM
OF PRIORITY PURSUANT TO 37 CFR 1.78(A)(3)**

Mail Stop PCT Legal Administration
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition pursuant to 37 CFR 1.78(A)(3) for acceptance of their unintentionally delayed claim of priority. under 35 U.S.C. § 120. It was intended that the above-identified application claim priority as a continuation-in-part (CIP) of prior-filed PCT application PCT/IL2002/000051 (Pub. No. WO/2002/056823). Indeed, the present application originally was filed with the following priority claim: "The present application is a continuation-in-part of application No. PCT/IL2002/000051, filed January 18, 2002, and claims priority from Israeli Patent Application No. 140970, filed January 18, 2001, the entire contents of each of which are hereby incorporated herein by reference." However, by Amendment of January 3, 2007, Applicants withdrew their priority claim "to both the Israeli priority application as well as the PCT international application of which the present application was previously designated as a CIP." Applicant's withdrawal of the priority claim to PCT/IL2002/000051 was an inadvertent

mistake, and Applicants now submit this Petition to reinstate it.

By Amendment previously submitted on May 28, 2008, Applicant has canceled the original (as-filed) priority claim and proposes to substitute therefore: "The present application is a continuation-in-part of International application No. PCT/IL2002/000051 (WO/2002/056823) filed January 18, 2002." At that time (May 28, 2008), applicant further petitioned for reinstatement of the priority claim under 35 U.S.C. 365(b). Applicant was advised on Sept. 16, 2008 by the Office Of Petitions and PCT Legal Administrations, Boris Milef, Legal Examiner, that the proper means for reinstatement of a claim under the present circumstance is by petition pursuant to 37 CFR 1.78(A)(3). Applicant paid, also at that time, the surcharge for the acceptance of an unintentionally delayed claim for priority of \$1410 as set forth in 1.17(t) from deposit account 50-3391 (posting reference no. 10621326 on 5/28/08).

Applicant hereby states that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. Applicant acknowledges the language of MPEP § 201.11(III)(G) wherein it states that, "[a] cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim..." and that "a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled ... may [be] refuse[d] ... because the delay was not unintentional." Applicant initially observes that the language of the MPEP on this point is permissive, i.e. "may be considered...", leaving to the discretion of the Examiner the determination of the Applicant's intent.

Applicant further observes that the language of MPEP § 201.11(III)(G) was

implemented, as it states, in anticipation of Public Law 103-465 which changed the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit is claimed for applications filed after June 8, 1995. At that time the Office expected that some applicants would desire to delete references claiming the benefit of earlier filed applications in order to maximize the prospective term of their protection. By § 201.11(III)(G) the Office sought to limit, at the discretion of the Examiner, the ability of an applicant to jettison a claim of priority to maximize term only to reinstate it as a shield should the Examiner identify relevant prior art. Such is not the case in the instant case.

Applicants have acknowledged, and continues to acknowledge, that the inadvertent withdrawal of said priority claim was entirely its mistake to begin with. Applicants, however, were not trying to modify the term of any patent that may issue on the application and are not now seeking safe harbor from newly identified prior art references. Indeed, applicants observe that all of the prior art references cited in the most recent Official Action (mail date 1/25/08) were also cited in the 9/1/2006 Official Action issued prior to the inadvertent and mistaken withdrawal of the claim of priority, save for the applicant's own disclosures, of which it was certainly aware prior to the errant amendment.^a As such, applicant is not benefiting from the elimination of previously unknown prior art by reinstatement of the claim of priority. Further, granting of the present Petition will not be to the public detriment in any manner as the present application was published (US 2004/0018987) with the priority data in place.

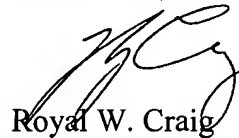
^a Examiner also cites on page 9 of the 1/25/08 Official Action Gura, *et al.* and Johnson, *et al.* as illustrative of the state of the art

Accordingly, the Applicant hereby requests that the Legal Examiner exercise his discretions and find that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. Applicant therefore further respectfully petitions that its priority claim under 37 CFR 1.78(A)(3) be reinstated. The inadvertent waiver of the PCT priority claim was a mistake, entirely unintentional, and approval of Applicant's Petition is thus believed to be in order.

I declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true.

I further declare that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or by both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-referenced patent application.

Respectfully submitted,



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Date 11/4/08

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